

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KARL VAN BLANKENBURG and EDWARD J. BELFOUR

Appeal No. 2005-1996
Application No. 09/923,694

ON BRIEF

Before GARRIS, OWENS and JEFFREY T. SMITH, Administrative Patent Judges.
JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1-8 and 16-20.¹ Claims 9-15, 21, and 22 are withdrawn as being non-elected.² We have jurisdiction under 35 U.S.C. § 134.

¹ The claimed subject matter on appeal has been at least twice rejected by the Examiner.

² Brief, p. 1.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Graf (Based on an application filed September 9, 1999)	6,421,934	Jul. 23, 2002
Reynolds	6,109,622	Aug. 29, 2000
Brown	4,783,911	Nov. 15, 1988

The Examiner rejected claims 1-8 and 16-20 under 35 U.S.C. § 103(a) as obvious over Graf and Reynolds. The Examiner also rejected claims 1-8 and 16-20 under 35 U.S.C. § 103(a) as obvious over Brown and Reynolds.³

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in support of their respective positions. This review has led us to conclude that the Examiner's rejections under 35 U.S.C. § 103(a) are well founded.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejections, we make reference to Appellants' Brief filed July 19, 2004 and the Examiner's Answer mailed September 13, 2004 and the Office action mailed April 2, 2004.

Appellants, Brief page 3, have indicated that the claims do not stand or fall together. However, Appellants have grouped their arguments for claims 1-8 together

³ Office action mailed April 2, 2004, pages 4 to 9.

and claims 16-20 together. Appellants have not presented separate arguments for the claims within the stated groups. Thus, we select claims 1 and 16 as representative of the argued groups of claims.

OPINION

To hold an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the reference teachings and combine them in a way that would produce the claimed invention. See, e.g., *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) (When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion, or motivation to make such a combination.) Evidence of a suggestion, teaching or motivation to combine may flow from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

Appellants' invention relates to an attachment for a goalie skate for receiving a goalie ice skate boot. The attachment includes a protective shell for a boot having opposed sidewalls and a sole joined by toe and heel portions. The attachment comprises a blade holder that is unitarily formed as part of the sole of the shell. The blade holder comprises an open-ended groove and at least two transversely

extending bores. The blade comprises at least two legs projecting from the blade for attachment to the holder. According to Appellants, the attachment for a goalie skate of the present invention is easier to use than previously devised goalie skate protective shells. (Brief, p. 3). Representative claims 1 and 16 are reproduced below:

1. An attachment to a goalie ice skate comprising:

a protective shell having first and second opposed side walls and a sole joined by toe and heel portions, the shell defining an interior cavity adapted for receiving a goalie ice skate boot;

a holder unitarily formed as part of the sole of the shell, the holder having an open ended groove extending lengthwise thereover;

at least two transversely extending bores formed in the holder;

a blade received in the open ended groove after the holder has been unitarily formed with respect to the shell, the blade having a blade edge and at least two legs projecting from the blade edge, apertures formed in the legs for alignment with a corresponding number of bores formed in the holder when the blade is mounted in the open ended groove in the holder; and

fasteners engagable through the apertures in the legs of the blade and the bores in the holder to removably affix the blade to the holder.

16. An attachment to a goalie ice skate comprising:

a sole having a first end and a second end;

a protective shell integrally formed with respect to the sole for receiving a goalie ice skate boot including a toe portion adjacent a first end of the sole and a heel portion adjacent a second end of the sole, the protective shell extending in a first direction from the sole; and

a blade holder integrally formed with respect to the sole and the protective shell including an open ended groove for receiving a blade subsequent to being formed with sole and the protective shell, the blade holder also

including at least one bore extending transverse to the open ended groove and adjacent one of the toe portion and the heel portion to receive a fastener for releasibly associating a blade with respect to the integrally formed sole, protective shell and blade holder.

The independent claims 1 and 16 require a blade holder that is integrally formed with respect to the sole and the protective shell including an open ended groove for receiving a blade subsequent to being formed with sole and the protective shell. The claims further specify that the blade holder includes at least one bore extending transverse to the open ended groove for receiving a fastener for releasibly associating the blade.

The Examiner rejected claims 1-8 and 16-20 under 35 U.S.C. § 103(a) as obvious over the combination of Graf and Reynolds. We affirm.

The Examiner determined that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the skate boot and getting up aid of Graf with the ice skate chassis having at least two transverse bores, apertures and fasteners as taught by Reynolds in order to provide an assembly that reduces the tendency of the blade to warp under increased loading conditions. (Answer, p. 5; Reynolds, col. 1, ll. 28-30). A person of ordinary skill in the art would have been further motivated to utilize a removable blade holder assembly in the blade holder assembly of Graf to obtain a blade that is easier to sharpen.

The Examiner found that the goalie skate of Graf discloses all of the claimed features except for the at least two transversely extending bores formed in the holder,

the apertures formed in the legs of the blade, the fasteners which are engaged through the apertures in the legs of the blade and the bores in the holder to removably affix the blade to the holder. (Answer, p. 5). Graf discloses "[s]kate boots are known to come in various designs. Specifically known are ice-hockey goalkeeper's skate boots because they generally include a boot leg having a lesser height than that of skate boots of the rest of a team. These skate boots can feature a known, conventional boot design or an also known design as shell boot having an outer shell of a plastic material and including an inner liner boot." (Col. II. 11-17). The object of the invention of Graf is "to provide a skate boot which enables specifically a goalkeeper to get up in a most easy way from a butterfly position, and where applicable eases also for a figure-skater the getting up from a sidewise splits." (Col. II. 33-37). Graf achieves this goal by mounting the getting up aid to the outer surface of the inner instep area of the skate boot. (Col. 2, II. 5-10).

The Examiner found that Reynolds teaches an ice skate chassis comprising a holder (having two transversely extending bores), a blade (comprising apertures in the legs) and fasteners (for attaching the blade to the holder). According to Reynolds, column 2 lines 21-24, the described ice skate blade assembly has improved torsional and longitudinal rigidity. Reynolds discloses

"[i]n conventional ice skate blade holder assemblies, a blade holder is secured to the skate boot and has a longitudinal slot into which the replaceable blade or 'runner' is installed. The blade holder is typically attached to or formed integrally with heel and toe portions that attach to the underside of the skate boot. [] This type of blade holder assembly has been extremely successful, particularly because the blade can be easily

removed and replaced without replacing the entire blade holder assembly." (Col. 1, ll. 10-19).

Reynolds further discloses:

[i]n standard skate blade sharpening machines, the arms containing the sharpening/grinding surfaces are located very close to each other, and clearance between these arms is extremely limited. In order to sharpen a skate blade installed in a skate blade assembly, the skate blade assembly must be sufficiently narrow to fit into the confined arm space so that the skate blade will contact the sharpening/grinding surfaces. If the skate blade assembly does not fit, the skate blade must be (1) sharpened manually; (2) removed from the skate blade assembly, sharpened and then reattached to the skate blade assembly; or (3) sharpened on a specially constructed sharpening machine. (Col. 1, ll. 52-63).

Thus, the invention of Reynolds addresses the problem of blade holder rigidity and the sharpening an ice skate blade attached to an ice skate blade holder. (See Reynolds column 1).

Appellants argue, Brief pages 3-4, that the Examiner has ignored or not given sufficient consideration and weight to the previously submitted 1.132 declaration. Appellants' position stated in the declaration is that the only process capable of mounting the blade in the holder portion of the shell shown in the drawing of Graf is through an insert molded process wherein the skate blade is supported in a mold and then the plastic injected into the mold and around and through a portion of the blade to form the shell and holder.

The statements of the declarant, paragraphs 3 and 4, are limited to the production of the skate described by Graf. The statement as to the molding process

used by Graf to mount the blade do not detract from the Examiner's obviousness determination. As stated above, persons of ordinary skill in the art would have recognized the difficulty in sharpening an ice skate blade mounted to a skate. Reynolds discloses a solution to this problem by designing a holder with a releasable holder for the blade. The declarant, paragraph 5, acknowledges Reynolds teaching of a releasable holder for an ice skate blade.

The declarant's statement in paragraph 7 about the complex molding design requiring unique tooling to make the protective shell is noted. However, these features of the molding apparatus are not claimed.

The Appellants have presented arguments directed to the applied prior art considered individually rather than to the combination of the stated reference and the admitted prior art. These arguments are not persuasive because obviousness cannot be rebutted by attacking references individually where the rejection is based upon the teachings of a combination of references. A reference must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. *In re Merck & Co.*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

For example, Appellants argue, Brief pages 8-9, "[d]ue to the insert molding process required to integrally mount the blade in the holder, Graf never forms an open-ended groove in the holder after the holder has been unitarily formed with the shell which is capable of receiving a blade fixable in the groove by fasteners. Graf is specific to an irremovable blade unitarily mounted by insert molded plastic to the holder

portion of the shell. Any feature that could function as a groove is formed around the blade so that the blade is not attached after the holder is formed as in Appellants' invention."

Appellants' argument is not persuasive. The Reynolds reference is cited for disclosing a removable blade assembly. A person of ordinary skill in the art would recognize that an open-ended groove in the holder would have been required for creating a receptacle for the removable blade as disclosed in Reynolds.

Appellants argue, Brief page 9, "the holder and removably blade of Reynolds is intended for use solely in a conventional ice skate and not a goalie skate attachment wherein a shell, holder and blade receive a slide-in ice skate boot. Reynolds lacks any shell capable of surrounding the boot and is, instead, fixedly secured to the bottom surface or sole of an ice skate boot by rivets."

Here again the Appellants' argument does not consider the rejection as stated by the Examiner. As stated above, Reynolds was cited for describing a removable blade assembly. The attributes of the holder shell for a goalie skate is described by Graf. Further, as stated above, there was a recognized problem of sharpening an ice skate blade in a skate holder. This problem existed due to the bulkiness of the holder. A goalie skate holder would have had the same bulkiness problem as a conventional skate holder. Thus, a person of ordinary skill in the art would have reasonably expected that the use of a releasable blade holder such as disclosed by Reynolds would have been suitable for the blade holder of Graf. "For obviousness under § 103,

all that is required is a reasonable expectation of success." *In re O'Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

The Examiner rejected claims 1-8 and 16-20 under 35 U.S.C. § 103(a) as obvious over the combination of Brown and Reynolds. We affirm.

The teachings of the Brown reference are substantially equivalent to the teachings of the Graf reference cited in the previously discussed rejection. Specifically, the Examiner cited Brown for disclosing a goalie skate shell holder. Appellants' arguments for patentability are substantially the same as presented for the previous rejection. (See Brief, pp. 10-17). Thus, we affirm for the reasons stated above.⁴

CONCLUSION

For the foregoing reasons and those set forth in the Answer, giving due weight to Appellants' arguments, we determine that the preponderance of evidence weighs in favor of the Examiner's rejections. Accordingly, the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) are affirmed.

⁴ We note that Appellants have relied on the declaration under 37 C.F.R § 1.132 discussed in the previous rejection. The declarant does not provide a discussion of the Brown reference. Thus, for this rejection, Appellants' discussion of the 1.132 declaration has been treated as unsupported Attorney arguments.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

Affirmed


JEFFREY T. SMITH
Administrative Patent Judge

**BOARD OF PATENT
APPEALS
AND
INTERFERENCES**

Appeal No. 2005-1996
Application No. 09/923,694

12

YOUNG & BASILE, P.C.
SUITE 624
3001 WEST BIG BEAVER ROAD
TROY, MI 48064-3107